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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,604	08/23/2001	Edwin Mellor Southern	2001_1178	9336

513 7590 06/16/2003

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EXAMINER

HORLICK, KENNETH R

ART UNIT PAPER NUMBER

1637

DATE MAILED: 06/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,604

Applicant(s)

SOUTHERN ET AL.

Examiner

Kenneth R Horlick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12 and 13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/930,798.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 (2 pages)
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

1. It is noted that instant claims 12 and 13 appeared in parent application 08/930,798 as claims 10 and 11, respectively. Claims 10 and 11 were prosecuted in said parent application, and the following art rejections from the '798 application are repeated below over instant claims 12 and 13.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 12 is rejected under 35 U.S.C. 102(e) as being anticipate by Nikiforov et al. (US 5,679,524).

This claim is drawn to an array of oligonucleotides wherein each one has a 3' nucleotide residue through which it is covalently attached to a support and a 5' nucleotide residue which is phosphorylated.

Nikiforov et al. disclose attachment of oligonucleotides to a solid support, wherein the 3' end is attached to said support and the 5' end is phosphorylated (see, for example, Fig. 1, top). This patent also discloses that oligonucleotides may be immobilized on the solid support "in specific patterns", i.e., as an array (see column 11, lines 6-64).

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stabinsky (US 4,797,355) in view of WO 89/10977.

This claim is drawn to a method comprising: providing a first intermediate oligonucleotide tethered to a known location of an array on a solid support, and a second intermediate oligonucleotide in solution, and a third oligonucleotide complementary to both the first and second intermediate oligonucleotides; forming a duplex of the third oligonucleotide with the first and second intermediate oligonucleotides; ligating the first and second oligonucleotides; and repeating these steps with oligonucleotides tethered to different locations of the support.

Stabinsky discloses a method comprising: providing a first oligonucleotide tethered to a solid support, and a second oligonucleotide in solution, and a third oligonucleotide complementary to both the first and second intermediate oligonucleotides; forming a duplex of the third oligonucleotide with the first and second

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oligonucleotides; and ligating the first and second oligonucleotides (see abstract and column 2, line 41 to column 3, line 62).

Stabinsky does not disclose forming an array of different oligonucleotides on the support using the method.

WO 89/10977 discloses the use of oligonucleotide arrays on solid supports for several purposes, including the detection of important genetic mutations (see abstract; page 3, lines 17-24; page 4, lines 19-30; example 4 on pages 19-20; page 22, lines 3-23).

One of ordinary skill in the art would have been motivated to apply the oligonucleotide probe-forming method of Stabinsky to multiple known portions of a solid support (i.e., and array) because WO 89/10977 disclosed that oligonucleotide arrays were advantageous in providing for detection of genetic mutations. It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to carry out the claimed method.

4. No claims are free of the prior art.
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Horlick whose telephone number is 703-308-3905. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers

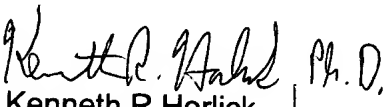
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for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Kenneth R Horlick | Ph.D.
Primary Examiner
Art Unit 1637

June 11, 2003